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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,589	04/09/2004	Yosuke Hosoya	09792909-5854	1893

26263 7590 01/03/2008  
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EXAMINER
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CANTELMO, GREGG

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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01/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/821,589

Applicant(s)

HOSOYA ET AL.

Examiner

Gregg Cantelmo

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1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/22/07 AND 9/18/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 22, 2007 has been entered.

### ***Response to Amendment***

2. In response to the amendment received September 18, 2007, entered as per the RCE October 22, 2007:

- a. Claims 1-5 are pending;
- b. The 112 rejections have been overcome in light of the amendment;
- c. The prior art rejections have been withdrawn in light of the amendment.

### ***Information Disclosure Statement***

3. The information disclosure statement filed October 22, 2007 has been placed in the application file and the information referred to therein has been considered as to the merits.

### ***Claim Objections***

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

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dependent form, or rewrite the claim(s) in independent form. Claim 2 recites that the inorganic compound is a lithium compound. However claim 1, as currently amended, now positively requires that the inorganic compound is selected only from lithium inorganic compounds. Thus claim 2 no longer further limits claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '643, of record, in view of either U.S. Patent No. 4,668,594 (Yamaura); U.S. Patent No. 5,958,281 (Takada) or U.S. Patent No. 6,475,663 (Mohwald).

JP '643 discloses a positive active material comprising: particles of a compound oxide of lithium and a transition metal 1 (figures and paragraphs 10 and 24) having an inherent layered structure thereby permitting the intercalation/deintercalation of lithium during charging/discharging and a coating layer on the active material 1 wherein the coating layer comprises an inorganic lithium compound 4 (paragraphs 10 and 23) and a carbonaceous conductive material 3 (paragraph 10 and 23 as applied to claim 1). The inorganic compound 4 is a lithium compound (paragraph 23 as applied to claims 1, 2 and 5). The weight ratio of the particles 1 to the coating 2/3/4 teaches of particle weights of 10 grams relative to about 1 gram of coating material (see examples for weight ratios). Thus JP '643 teaches that the weight ratio of the particles will clearly be at least 70% but less than 98% relative to the coating layer 2/3/4 (as applied to claim 4).

JP '643 discloses a nonaqueous secondary battery comprising: a negative active material and a positive active material comprising: particles of a compound oxide of lithium and a transition metal 1 (figures and paragraphs 10 and 24) having an inherent layered structure thereby permitting the intercalation/deintercalation of lithium during charging/discharging and a coating layer on the active material 1 wherein the coating

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layer comprises an inorganic lithium compound 4 (paragraphs 10 and 23) and a carbonaceous conductive material 3 (paragraph 10 and 23 as applied to claim 1).

JP '643 does not specify that the inorganic material is either lithium iron phosphate or lithium phosphate (claims 1 and 5) or the weight ratio between the inorganic material to the carbonaceous material being between 99:1 and 60:40 (claim 3).

Regarding the inorganic material being either lithium iron phosphate or lithium phosphate (claims 1 and 5):

Essentially JP '643 teaches of coating lithium metal oxide base particles with a mixture of an inorganic conducting material and an electron conducting material.

While the inorganic conducting materials taught by JP '643 are not inclusive of either lithium iron phosphate or lithium phosphate, JP '643 does teach that the inorganic material is a lithium ion conductive inorganic solid electrolyte material (see abstract).

Thus one of ordinary skill in the art would have reasonably appreciated that the inorganic material coated on the positive electrode active material could reasonably be any known teach that the inorganic material is a lithium ion with a reasonable expectation that any such combination would effectively operate in the desired manner taught by JP '643, absent clear evidence to the contrary.

Each of lithium iron phosphate and lithium phosphate are art recognized ion conductive materials used in lithium secondary batteries as shown by either Yamaura (col. 5, ll. 33-37); Takada (col. 1, ll. 32-55); or Mohwald (col. 4, ll. 43-65). Thus it would have been apparent to one of ordinary skill in the art to use either lithium iron phosphate

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or lithium phosphate as an alternative ion conducting inorganic material coated onto the positive electrode since the primary reference teaches that it is generally known to coat lithium metal oxide base particles with a mixture of a lithium ion conducting inorganic material and an electron conducting material and since the specific inorganic materials of lithium iron phosphate and lithium phosphate are art recognized ion conductive materials used in lithium secondary batteries as shown by either Yamaura, Takada, or Mohwald.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of JP '643 by selecting the lithium ion conducting inorganic material to be either lithium iron phosphate or lithium phosphate since such materials are art recognized lithium ion conducting inorganic materials as shown by either Yamaura, Takada, or Mohwald and one of ordinary skill in the art would have found such a modification to have provided the predictable result of providing a coating to the positive active material having both the requisite electron conducting and lithium ion conducting properties. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP § 2144.07. See also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Regarding the weight ratio between the inorganic material to the carbonaceous material being between 99:1 and 60:40 (claim 3):

While JP '643 discloses providing both an inorganic component 4 and carbon component 3 in a coating material to a positive active material 1, the disclosure does not specifically teach of the ratio of these two materials, however it is clear that there is an inherent ratio between these two components.

Varying the amount of each of components 2, 3 and 4 of the coating layer are recognizable optimizable components. One of ordinary skill in the art would have recognized that by varying the amount of carbon in the film, the electronic conductivity of film would vary accordingly. One of ordinary skill in the art would have also recognized that by varying the amount of the inorganic lithium compound in the film, the ionic conductivity of the film would vary accordingly. Adjusting the ratios of both materials will optimize the ionic and electronic conductivity of the film and selection of the claimed ratio would have been obvious to one of ordinary skill in the art since it would have provided a coating which exhibited optimal ionic and electronic conductivities.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of JP '643 by adjusting the ratios of both the carbon component and inorganic component of the film of JP '643 within the ratio defined in claim 3 since the optimization of these would have been a recognized result-effective variable which could have been optimized since it would have provided a coating which exhibited optimal ionic and electronic conductivities.

Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is



critical. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). It has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a prima facie rejection is properly established when the difference in the range or value is minor. Titanium Metals Corp. of Am. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

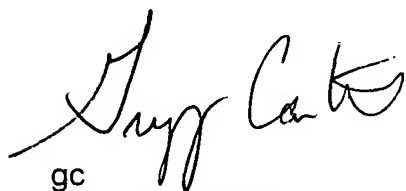
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



gc

January 2, 2008

Gregg Cantelmo  
Primary Examiner  
Art Unit 1795